

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:) Examiner: V. Johnson
TADASHI ICHIDA) Art Unit: 3682
Application No.: 10/001,324)
Filed: November 23, 2001) REPLY BRIEF
For: METHOD AND APPARATUS FOR)
SHIFITNG A BICYCLE)
TRANSMISSION)

Commissioner for Patents
Washington, D.C. 20231

Commissioner:

This is a reply brief for the above-captioned matter.

As noted previously, the only reason why Browning moves to a destination gear ratio other than the requested gear ratio is to avoid an illegal destination gear. The Appellant submits that, once it is decided not to implement the concept of illegal gears, as recited in independent claims 1 and 20, then any reason to move to a destination gear other than the one requested vanishes.

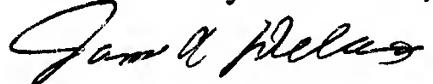
Furthermore, while the Appellant already took issue with the statement that “the omission of a step or element is obvious if the function is not desired,” it also should be noted that not one exemplary environment was provided where the concept of legal gears is *not* desired. Browning actually teaches away from the proposed modification because of the undesirable effect an illegal gear has on the rider while pedaling.

As for the disputed text at column 3, lines 24-28 of Colbert, et al, it is the examiner that maintains that column 3, lines 24-28 of Colbert, et al. provides support for the position that the provision of a speed sensor and an automatic shift control unit improves efficiency. The cited text

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simply does not say that. The burden is on the examiner to provide the nexus between the cited text and the allegation, but no such nexus was provided. The Examiner's Answer merely states that "it is believed that the entire disclosure of the above noted references provide teachings that improve efficiency and/or safety." However, the factual question of motivation is material to patentability and cannot be resolved on subjective belief and unknown authority. *In re Lee*, 277 F.3d 1338, 61 USPQ2d 1430, 1434 (Fed.Cir. 2002). One cannot rely on conclusory statements when dealing with particular combinations of prior art and specific claims, but must set forth the rationale on which he/she relies. *Id.*

Respectfully submitted,



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